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Finnegan, Henderson, Farabow			BETIT, JACOB F		
ner, L.L.P.					
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r	01/09/2002 7590 12/30/2004 enderson, Farabow nner, L.L.P. N.W.	01/09/2002 Tadashi Noguchi 7590 12/30/2004 enderson, Farabow nner, L.L.P. N.W.	01/09/2002 Tadashi Noguchi 05905.0156 7590 12/30/2004 EXAM enderson, Farabow nner, L.L.P. N.W. ART UNIT		

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

		Applicati	on No.	Applicant(s)			
Office Action Summary		10/040,3	69	NOGUCHI, TADASHI			
		Examine	r	Art Unit			
		Jacob F.	Betit	2164			
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply							
A SHOR THE MA - Extension after SIX - If the peri - If NO peri - Failure to Any reply	TENED STATUTORY PERIOD FO ILING DATE OF THIS COMMUNIC as of time may be available under the provisions of (6) MONTHS from the mailing date of this community of for reply specified above is less than thirty (30) is do for reply is specified above, the maximum stature reply within the set or extended period for reply wire received by the Office later than three months after them term adjustment. See 37 CFR 1.704(b).	ATION. 37 CFR 1.136(a). In no exication. days, a reply within the statory period will apply and v II, by statute, cause the app	vent, however, may a reply be tim tutory minimum of thirty (30) days vill expire SIX (6) MONTHS from to blication to become ABANDONEC	nely filed s will be considered timely the mailing date of this co O (35 U.S.C. § 133).			
Status							
1)⊠ Re	1)⊠ Responsive to communication(s) filed on <u>06 August 2004</u> .						
2a)⊠ Th)⊠ This action is FINAL . 2b)□ This action is non-final.						
	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
Disposition	of Claims						
4a) 5)☐ Cla 6)⊠ Cla 7)☐ Cla	4) ☐ Claim(s) 1-28 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) 1-28 is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and/or election requirement.						
Application	Papers						
 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. 							
Priority und	er 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.							
				SAM F PRIMARY	RIMELL EXAMINER		
Attachment(s)	Defended (DTO 200)						
2) Notice of 3) Information	References Cited (PTO-892) Draftsperson's Patent Drawing Review (PTCon Disclosure Statement(s) (PTO-1449 or PTO) (s)/Mail Date		4) Interview Summary (Paper No(s)/Mail Da 5) Notice of Informal Pa 6) Other:)-152)		

DETAILED ACTION

Remarks

1. In response to communications filed on 06-August-2004, claims 1-2, 4, 15, 17, and 28 are amended per applicant's request. Claims 1-28 are presently pending in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 3. Claims 1-7, 12-20, and 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Buchanan et al. (U.S. patent No. 5,267,155).

As to claim 1, <u>Buchanan et al.</u> teaches an information processing system (see column 2, lines 41-53) comprising:

a module for scanning first data to be used by application software and extracting information for searching a database (see column 5, lines 13-26);

a module for extracting second data from a database on the basis of the extracted information (see column 5, lines 39-65); and

a module for inserting the second data into the location from which the information of the first data has been extracted (see column 6, lines 34-50).

As to claim 2, <u>Buchanan et al.</u> teaches an information processing system (see column 2, lines 41-53) comprising:

a search information storage module for storing first information for searching a database in association with identification information (see column 5, lines 13-17);

an identification information extracting module for extracting the identification information by scanning the first data to be used by application software (see column 5, lines 17-26);

a search information extracting module for extracting the first search information corresponding to the extracted identification information by referring to the search information storage module (see column 5, lines 27-30);

a data extracting module for extracting second data by searching a database on the basis of the extracted first search information (see column 5, lines 39-65); and

a data inserting module for inserting the extracted second data into the location from which the identification information of the first data has been extracted (see column 6, lines 34-50).

As to claim 14, <u>Buchanan et al.</u> teaches an information processing method comprising (see column 2, lines 41-53) the steps of:

scanning first data to be used by application software and extracting information for searching a database (see column 5, lines 13-26);

extracting second data from a database on the basis of the extracted information (see column 5, lines 39-65); and

inserting the second data into the location from which the information of the first data has been extracted (see column 6, lines 34-50).

As to claim 15, <u>Buchanan et al.</u> teaches an information processing method (see column 2, lines 41-53) comprising:

an identification information extracting step of scanning first data to be used by application software, thereby extracting identification information (see column 5, lines 13-17);

a search information extracting step of referring to search information storage module for storing first information for searching a database in association with identification information, thereby extracting the first search information corresponding to the extracted identification information (see column 5, lines 17-30);

a data extracting step of searching a database on the basis of the extracted first search information, thereby extracting second data (see column 5, lines 39-65); and

a data insertion step of inserting the extracted second data into the location from which the identification information of the first data has been extracted (see column 6, lines 34-50).

As to claims 3 and 16, <u>Buchanan et al.</u> teaches wherein the first search information at least includes information for specifying a database and information for specifying a part or all of the search conditions (see column 6, lines 34-46).

As to claims 4 and 17, <u>Buchanan et al.</u> teaches wherein the identification information extracting module extracts, in addition to the identification information, second information for

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searching a database, the second search information being located in association with the identification information, and the data extracting module searches a database on the basis of the first search information and the second search information (see column 6, lines 23-33).

As to claims 5 and 18, <u>Buchanan et al.</u> teaches wherein the second search information at least includes information for specifying a part or all of the search conditions (see column 6, lines 23-33).

As to claims 6 and 19, <u>Buchanan et al.</u> teaches wherein the system can register or update the first search information with the search information storage module on the basis of user input (see column 4, line 33 through column 5, line 12).

As to claims 7 and 20, <u>Buchanan et al.</u> teaches wherein the search information storage module stores a plurality of the first search information by classifying it into a plurality of groups (see column 4, line 58 through column 5, line 12).

As to claims 12-13, and 25-26, <u>Buchanan et al.</u> teaches wherein at least any one of the inputs or outputs to the application software, database, or the user, is performed through a communication network (see column 10, lines 1-6).

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As to claim 27, <u>Buchanan et al.</u> teaches a computer readable recording medium with a program stored therein for performing on a computer the information processing method according to claim 14 (the applicant is referred to the remarks and discussions made for claim 14 above, where it is inherent that the method and system described would most commonly be preformed using a program stored on one or more hard disks in one or more computers; and see figure 1).

As to claim 28, <u>Buchanan et al.</u> teaches a computer readable recording medium with a program stored therein for performing on a computer the information processing method according to claim 15 (the applicant is referred to the remarks and discussions made for claim 15 above, where it is inherent that the method and system described would most commonly be preformed using a program stored on one or more hard disks in one or more computers; and see figure 1).

Claim Rejections - 35 USC § 103

- 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 8-9 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan et al. (U.S. patent No. 5,267,155) in view of Van Huben et al. (U.S. patent No. 6,327,594).

As to claims 8-9 and 21-22 <u>Buchanan et al.</u> does not teach wherein the application software is spreadsheet software and the first data is tabular data.

Van Huben et al. teaches a common access method that enables disparate pervasive computers to interact with centralized data management systems (see abstract), in which he teaches wherein the application software is spreadsheet software and the first data is tabular data (see column 25, lines 49-63).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified <u>Buchanan et al.</u> to include wherein the application software is spreadsheet software and the first data is tabular data.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified <u>Buchanan et al.</u> by the teachings of <u>Van Huben et al.</u> because wherein the application software is spreadsheet software and the first data is tabular data would be a simple application that would provide tabular data format and perform sort and search operations on fields (see <u>Van Huben et al.</u>, column 25, lines 58-63).

6. Claims 10-11 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan et al. (U.S. patent No. 5,267,155) in view of Salas et al. (U.S. patent No. 6,233,600 B1).

As to claims 10-11 and 23-24 <u>Buchanan et al.</u> does not teach wherein the application software is browser software and the first data is document data described in a structured tag language such as html.

Salas et al. teaches wherein the application software is browser software and the first data is document data described in a structured tag language such as html (see column 6, lines 40-56).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified <u>Buchanan et al.</u> to include wherein the application software is browser software and the first data is document data describéd in a structured tag language such as html.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified <u>Buchanan et al.</u> by the teachings of <u>Salas et al.</u> because wherein the application software is browser software and the first data is document data described in a structured tag language such as html would allow users to share files over time zones and geographic boundaries (see Salas et al., abstract).

Response to Arguments

7. Applicant's arguments filed 06-August-2004 have been fully considered but they are not persuasive.

In response to the applicant's arguments that "<u>Buchanan</u> does not teach at least 'a module for scanning a first data to be used by application software and extracting information for

searching a database' and 'a module for extracting second data from a database on the basis of the extracted information'", the arguments have been fully considered but are not deemed persuasive because <u>Buchanan et al.</u> teaches both of these claimed limitations. "[A] module for scanning a first data to be used by application software and extracting information for searching a database" is equivalent to "scanning the document template for variable identifiers" (<u>Buchanan et al.</u> column 5, line 18). "[A] module for extracting second data from a database on the basis of the extracted information" is equivalent to "retrieve and manipulate character strings used to fill "holes" in the document template" (<u>Buchanan et al.</u>, column 5, lines 48-49). This is because the variable identifiers are used in finding the data from the relational databases to fill the "holes".

In response to the applicant's arguments that "the Examiner has not shown adequate motivation to combine Buchanan and Van Huben", the arguments have been fully considered but are not deemed persuasive because the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references cited contain inventions that are in the same field of endeavor. Van Huben et al. teaches a database system that uses shared data management for retrieving data in a computing environment (see abstract) in which he teaches "wherein the application software is spreadsheet software and the first data is tabular data (see column 25, lines 49-63). Therefore, it would have been obvious to a person having ordinary skill

in the art at the time the invention was made to have modified <u>Buchanan et al.</u> by the teachings of <u>Van Huben et al.</u> It is well known in the art that spread sheets provide sort and search operations on fields (see <u>Van Huben et al.</u>, column 25, lines 58-63). This would be a convenient way for scanning the document for variable identifiers (see <u>Buchanan et al.</u>, column 5, lines 13-26).

In response to the applicant's arguments that "the Examiner has not offered any reasonable expectation of success for modifying the <u>Buchanan</u> system for processing document templates with the <u>Van Huben</u> method ...", the argument has been fully considered but is not deemed persuasive because the applicant has not explained why there is no reasonable expectation for success. Further it is noted that both <u>Buchanan et al.</u> and <u>Van Huben et al.</u> disclose methods and systems for manipulating and accessing data in database systems, which is very much in the same art area, and therefore it is not conceivable why the modification of <u>Buchanan et al.</u> by the teachings of <u>Van Huben et al.</u> would not succeed.

In response to the applicant's arguments that "the Examiner has not offered any reasonable expectation of success for modifying the <u>Buchanan</u> system for processing document templates with the <u>Salas</u> system for sharing files", the arguments have been fully considered, but are not deemed persuasive because the applicant has not explained why there is not reasonable expectation for success. Further it is noted that both <u>Buchanan et al.</u> and <u>Salas et al.</u> deal with databases and using identifiers to indicate where information should be inserted at a later time,

and therefore it is not conceivable why the modification of <u>Buchanan et al.</u> by the teachings of <u>Salas et al.</u> would not succeed.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob F. Betit whose telephone number is (571) 272-4075. The examiner can normally be reached on Monday through Friday 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571) 272-4083. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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jfb

15 Dec 2004

SAM RIMELL PRIMARY EXAMINER